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EXAMINER

VU, THONG H

ART UNIT PAPER NUMBER

2142

DATE MAILED: 04/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/686,255

Applicant(s)

MANBER ET AL

Examiner

Thong H. Vu

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 7-14, 17-25, 27 and 28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 7-14, 17-25, 27 and 28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10/03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

1. Claims 1-4,7-14,17-25,27-28 are pending. Claims 5-6,15-16, 26 are canceled.

Priority

2. This is a Continuation application 09/510,201 filed on 2/22/2000 now USP 6,651,086. This Office Action response to the Preliminary Amendment filed 10/14/03.

Claim Rejections - 35 USC § 112

3. Claims 1-29 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for communicate via instant messaging session, does not reasonably provide enablement for connect to instant messaging server. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to experiment the invention commensurate in scope with these claims. (i.e.: the first and second user via a messaging server wherein the first user and the second user were not connected to the messaging session); (wherein the first user and the second user are not in an instant messaging session was not disclosed in specification).
4. Claims 1-28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.(It was unclear How a first and second user who were not connected to the session could received a comment ?. It also unable to a skill in the art to perform an undue experiment for established communication between the first and second user via

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a messaging server wherein the first user and the second user were not connected to the messaging session).

5. Claims 1,12,24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. (i.e.: the users are not connected in a session).

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-28 are rejected under the judicially created doctrine of double patenting over claims 1-23 of U. S. Patent No. 6,651,086 B1 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

('086) 1. A method, in a messaging server, of connecting parties with mutual interests, comprising the steps of: presenting a media object to a first user; receiving a first comment from the first user; presenting the media object and the first comment to a second user such that the first comment and the media object are displayed proximal each other to the second user; receiving a reply comment from the second user responsive to the first comment; presenting the reply comment to the first user, wherein the first and second user are not connected in an instant messaging session; and thereafter if the reply comment fits a matching criteria, connecting the first and the second user in an instant messaging session.

2. the matching criteria is in the form of an approval indication of the reply comment received from the first user.

3. the media object includes one, or a combination, of a video clip, an audio clip, a graphic or a text object.

4. presenting the media object and the first comment to a third user and subsequent users until a predetermined display count is reached; presenting the first user with reply comments received from the third or subsequent users; and if any of the reply comments from the third or subsequent users are accepted by the first user, connecting the users having made acceptable reply comments to the instant messaging session.

5. the predetermined display count is a function of a parameter settable by the first user.

6. a plurality of media objects are associated with nodes in a hierarchical topic network and comments accepted are associated with the nodes.

7. receiving an association from the first user associating the first comment with one of the nodes; and presenting users' subsets of comments that are associated with a subset of the nodes.

8. limiting the subset of nodes to one parent node and the nodes that are descendants of the one parent node.

9. a plurality of media objects are associated with a concept, and wherein comments received are associated with one of the concept and a specific one of the plurality of media objects.

(Application) 1. A method, in a messaging server, of connecting parties with mutual interests, comprising the steps of: presenting a media object to a first user; accepting a first comment from the first user; presenting the media object to a second user along with the first comment; accepting a reply comment from the second user; and if the reply comment fits a matching criteria, connecting the first and the second user in a messaging session.

2. the matching criteria is in the form of an approval indication by the first user of the reply comment.

3. the media object includes one, or a combination, of a video clip, an audio clip, a graphic or a text object.

4. presenting the media object and the first comment to a third user and subsequent users until a predetermined display count is reached; presenting the first user with reply comments accepted from the third or subsequent users; and if any of the reply comments from the third or subsequent users are accepted by the first user, connecting the users having made acceptable reply comments to the messaging session.

7. the predetermined display count is a function of a parameter settable by the first user.

8. a plurality of media objects are associated with nodes in a hierarchical topic network and comments accepted are associated with the nodes.

9. accepting an association from the first user associating the first comment with one of the nodes; and presenting users' subsets of comments that are associated with a subset of the nodes.

10. limiting the subset of nodes to one parent node and the nodes that are descendants of the one parent node.

11. a plurality of media objects are associated with a concept, and wherein comments accepted are associated with one of the concept and a specific one of the plurality of media objects.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Response to Arguments

7. Applicant's arguments filed 3/11/05 have been fully considered but they are not persuasive to overcome the prior art.

Applicant argues the prior art does not teach or suggest the first user and second user are not connected in an instant messaging session and if the reply comment fits a matching criteria, connecting the first and the second user in an instant messaging session.

Examiner points out the prior art taught a chat system with a desired form [Okada, desired form, col 2 lines 32-45] wherein an agent connected the server and the plurality of client workstations, the agent reads the records (or matching criteria) from the stored log file (or memory contains the comments) when the records match the previously stored conditions, then the connection is established (or approved) [Okada, col 22 lines 30-62].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-4,7-14,17-25,27-28 are rejected under 35 U.S.C. § 103 as being unpatentable over Barrett et al [Barrett 6,400,381 B1] in view of Okada et al [Okada 6,363,461 B1].

9. As per claim 1, Barrett discloses a method, in a messaging server, of connecting parties with mutual interests [Barrett, a chat room, abstract], comprising the steps of:

providing a media object to be display to a first user [Barrett, a chat window, col 5 lines 15-25];

receiving a first comment from the first user [Barrett, the client applet identifies the user to the chat server, col 5 lines 1-15];

providing the media object to be display to a second user along with the first comment [Barrett, the documents accessed by a first client computer, col 6 lines 1-27];

receiving a reply comment from the second user [Barrett, accessed by a second client computer, col 6 lines 1-27]; and

However Barrett does not explicitly detail wherein the first user and second user are not connected in an instant messaging session if the reply comment fits a matching criteria, connecting the first and the second user in an instant messaging session".

In the same endeavor, Okada discloses a chat system with a desired form [Okada, desired form, col 2 lines 32-45] wherein an agent connected the server and the plurality of client workstations, the agent reads the records (or matching criteria) from the stored log file (or memory contains the comments) when the records match the

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previously stored conditions, then the connection is established (or approved), col 22 lines 30-62].

Therefore, it would have been obvious to an ordinary skill in the art at the time of the invention was made to incorporate the matching record as an approval indication as taught by Okada into the Barrett's apparatus in order to utilize the chat form. Doing so would provide a speedy preparation of the record of chat room.

10. As per claim 2, Barrett-Okada disclose the matching criteria is in the form of an approval indication by the first user of the reply comment [Okada, desired form, col 2 lines 32-45].

11. As per claim 3, Barrett-Okada disclose the media object includes one, or a combination, of a video clip, an audio clip, a graphic or a text object [Barrett, Web pages, col 4 lines 53-65].

12. As per claim 4, Barrett-Okada disclose presenting the media object and the first comment to a third user and subsequent users until a predetermined display count is reached; presenting the first user with reply comments accepted from the third or subsequent users; and if any of the reply comments from the third or subsequent users are accepted by the first user, connecting the users having made acceptable reply comments to the messaging session [Barrett, a private chat line, col 5 lines 37-47. It

was clearly that the first user created a private chat line and email to the second, third or subsequent users who provide the reply comments and connect to chat session].

13. As per claim 7, Barrett-Okada disclose the predetermined display count is a function of a parameter settable by the first user [Barrett, predefined criteria, col 6 lines 1-27].

14. As per claim 8, Barrett-Okada disclose a plurality of media objects are associated with nodes in a hierarchical topic network and comments accepted are associated with the nodes [Barrett, the web pages accepted the users accesses over a hierarchical topic or menu, col 5 lines 37-47].

15. As per claim 9, Barrett-Okada disclose accepting an association from the first user associating the first comment with one of the nodes; and presenting users subsets of comments that are associated with a subset of the nodes [Barrett, defines communication grouping, col 5 lines 49-65].

16. As per claim 10, Barrett-Okada disclose limiting the subset of nodes to one parent node and the nodes that are descendants of the one parent node [Barrett, the place server defines communicating grouping of similar users, col 5 lines 49-65].

17. As per claim 11, Barrett-Okada disclose a plurality of media objects are associated with a concept, and wherein comments accepted are associated with one of the concept and a specific one of the plurality of media objects as inherent features of private chat line.

18. As per claim 12, Barrett-Okada disclose a method, in a messaging server, of connecting parties with mutual interests, comprising the steps of:

providing a media object to for display a plurality of users [Barrett, a chat window, col 5 lines 15-25];

receiving a first comment from a first one of the plurality of users [Barrett, the client applet identifies the user to the chat server, col 5 lines 1-15];

providing the media object and the first comment for display to the plurality of users [Barrett, the chat from all of users of the communication grouping, col 5 lines 15-25];

receiving a reply comment from a second one of the plurality of users [Barrett, accessed by the second computer, col 6 lines 1-28]

providing the reply comment to the first user wherein the first user and the second user are not in an instant messaging session [Barrett, the chat from all of users of the communication grouping, col 5 line 15-col 6 line 28]; and

connecting the first and the second user in an instant messaging session if the first user indicates approval of the reply comment [Okada, the record which is in a desired form match to of the previously stored conditions, col 22 lines 30-62].

19. Claims 13-14,17-21 contains the similar limitations as the claims 3-4,7-11. Thus claims 13-14,17-21 are rejected by the same rational set forth claims 3-4,7-11.

20. As per claim 22, Barrett-Okada disclose the media object includes a link to the first comment Barrett, a web page with URL, col 4 lines 39-52].

21. As per claims 23,25 Barrett-Okada disclose the second user selecting the link, wherein selection of the link provides a list of one or more comments including the first comment as inherent feature of private chat line.

22. As per claim 27, Barrett-Okada disclose providing the first comment to the second user in response to a search inquiry entered by the second user [Barrett, a search engine, col 5 lines 49-65].

23. As per claim 28, Barrett-Okada disclose the search inquiry is a keyword search [Barrett, a search engine, col 5 lines 49-65].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

24. Claims 1-4,7-14,17-25,27-28 are rejected under 35 U.S.C. § 103 as being unpatentable over Olivier et al [Olivier 6,400,885 B1] in view of Ng et al [Ng, 6,424,647 B1].

25. As per claim 1, Olivier discloses a method, in a messaging server, of connecting parties with mutual interests [Olivier, instant messaging server, col 24 lines 1-22], comprising the steps of:

providing a media object to be displayed to a first user [Olivier, displayed to the user, col 25 lines 20-40; object ID, col 6 lines 63-67];

receiving a first comment from the first user [Olivier, recommended business, col 3 lines 55-60; recommend, col 22-28];

providing the media object to be displayed to a second user along with the first comment [Olivier, object ID, col 6 lines 63-67; meta-subscription, col 19 lines 17-30];

receiving a reply comment from the second user wherein the first user and the second user are not connected in an instant messaging session [Olivier, reply to message, col 10 lines 28-42, col 16 lines 25-55, col 17 lines 1-6, col 22 lines 32-45; interact with subscribers based on matched criteria, col 10 lines 43-59]; and Olivier also discloses matching criteria and making data available to all members, col 6 lines 1-27].

However Olivier does not explicitly detail "if the reply comment fits a matching criteria, connecting the first and the second user in an instant messaging session".

In the same endeavor of using instant messaging via Internet, Ng discloses a simpler technique is provided, which established an automatic call connection by

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matching source and destination locations on the Internet and allows for fine tuning the connection timing [Ng, automatic connection, col 15 lines 39-50, instant messages, col 20 line 46-col 21 line 3]

Therefore, it would have been obvious to an ordinary skill in the art at the time of the invention was made to incorporate the automatic connection the source and destination when the matching technique is provided as taught by Ng into the Olivier's apparatus in order to take advantage of matching criteria process. Doing so would provide a high quality interaction within electronic form.

26. As per claim 2, Olivier-Ng disclose the matching criteria is in the form of an approval indication by the first user of the reply comment [Olivier, submits the subscription form, col 9 lines 30-40].

27. As per claim 3, Olivier-Ng disclose the media object includes one, or a combination, of a video clip, an audio clip, a graphic or a text object [Ng, video, audio, graphics, col 13 lines 49-58].

28. As per claim 4, Olivier-Ng disclose

providing the media object and the first comment to a third user and subsequent users until a predetermined display count is reached [Olivier, interact with subscribers based on matched criteria, col 10 lines 43-59];

providing the first user with reply comments received from the third or subsequent users [Olivier, reply communication, col 32 lines 5-15]; and

if any of the reply comments from the third or subsequent users are accepted by the first user, connecting the users having made acceptable reply comments to the instant messaging session [Ng, automatic connection, col 15 lines 39-50, instant messages, col 20 line 46-col 21 line 3].

29. As per claim 7, Olivier-Ng disclose the predetermined display count is a function of a parameter settable by the first user [Olivier, display matches in colors, col 24 lines 23-47].

30. As per claim 8, Olivier-Ng disclose a plurality of media objects are associated with nodes in a hierarchical topic network and comments accepted are associated with the nodes [Olivier, topics, col 5 lines 23-32, col 8 lines 31-43, col 10 lines 43-59, col 11 lines 9-23, col 13 lines 55-67].

31. As per claim 9, Olivier-Ng disclose accepting an association from the first user associating the first comment with one of the nodes; and presenting users subsets of comments that are associated with a subset of the nodes [Olivier, sub groups, subset of users, col 5 lines 46-67].

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32. As per claim 10, Olivier-Ng disclose limiting the subset of nodes to one parent node and the nodes that are descendants of the one parent node [Olivier, sub groups, subset of users, col 5 lines 46-67].

33. As per claim 11, Olivier-Ng disclose a plurality of media objects are associated with a concept, and wherein comments accepted are associated with one of the concept and a specific one of the plurality of media objects [Olivier, recommended business, col 3 lines 55-60; recommend, col 22-28].

34. As per claim 12, Olivier-Ng disclose a method, in a messaging server, of connecting parties with mutual interests, comprising the steps of:

providing a media object to a plurality of users [Olivier, a chat window, col 3 lines 23-32];

receiving a first comment from a first one of the plurality of users [Olivier, recommended business, col 3 lines 55-60; recommend, col 22-28]

providing the media object and the first comment to the plurality of users [Olivier, object ID, col 6 lines 63-67; meta-subscription, col 19 lines 17-30];

receiving a reply comment from a second one of the plurality of users [Olivier, reply to message, col 10 lines 28-42, col 16 lines 25-55, col 17 lines 1-6, col 22 lines 32-45; reply communication, col 32 lines 5-15; group communications, col 4 lines 48-63];

providing the reply comment to the first user wherein the first user and the second user are not in an instant messaging session [Olivier, interact with subscribers based on matched criteria, col 10 lines 43-59]; and

connecting the first and the second user in a messaging session if the first user indicates approval of the reply comment [Olivier, submits the subscription form, col 9 lines 30-40].

35. Claims 13-14,17-21 contains the similar limitations as the claims 3-4,7-11. Thus claims 13-14,17-21 are rejected by the same rational set forth claims 3-4,7-11.

36. As per claim 22, Olivier-Ng disclose the media object includes a link to the first comment [Olivier, recommended business, col 3 lines 55-60; recommend, col 22-28].

37. As per claims 23,25 Olivier-Ng disclose the second user selecting the link, wherein selection of the link provides a list of one or more comments including the first comment as inherent feature of private chat line.

38. As per claim 27, Olivier-Ng disclose providing the first comment to the second user in response to a search inquiry entered by the second user [Olivier, a search engine, col 6 lines 34-53].

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39. As per claim 28, Olivier-Ng disclose the search inquiry is a keyword search

[Olivier, a search engine, col 6 lines 34-53].

Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Thong Vu, whose telephone number is (571)-272-3904. The examiner can normally be reached on Monday-Thursday from 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, *Jack Harvey*, can be reached at (571) 272-3896. The fax number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PMR or Public PMR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thong Vu
Patent Examiner
Art Unit 2142

A handwritten signature in black ink, appearing to read 'Thong Vu', with a horizontal line underneath.